

REMARKS

Upon entry of this amendment, claims 1-3, 6-12, 17-22, 12-31 and 36-40 are all of the claims pending in the application. Claims 4, 13, 14, 16, 23, 32, 33 and 35 are canceled by this amendment.

I. Information Disclosure Statement (IDS) filed on May 2, 2005

Regarding the IDS filed on May 2, 2005, Applicants note that the Examiner has indicated in the Office Action that two of the references (EP 0 447 154 and EP 0 903 594) listed on the corresponding PTO-1449 Form were not submitted to the PTO along with the IDS.

Applicants are enclosing herewith the stamped postcard receipt from the PTO indicating that all five of the references submitted with the above-noted IDS were received by the PTO on May 2, 2005. However, for the Examiner's convenience, Applicants are submitting duplicate copies of the above-noted references, along with a clean copy of the above-noted Form PTO-1449.

In view of the foregoing, Applicants kindly request that the Examiner consider the references listed on the PTO-1449 form and return the initialed and signed form with the next Office paper.

II. Claim Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-4, 10-13, 17, 18, 20-23, 29-32, 36, 37, 39 and 40 under 35 U.S.C. § 102(b) as being anticipated by Burd et al. (U.S. 5,939,331).

Claim 1 recites the feature of a space forming part which forms a cavity part, wherein the cavity part is a space into which an inspection target solution flows by a capillary phenomenon. Applicants respectfully submit that Burd fails to disclose or suggest at least this feature of claim 1.

Regarding Burd, Applicants note that this reference discloses a device for detecting the presence, absence, or amount of an analyte in a whole blood sample (see Abstract). As shown in Fig. 1 of Burd, the device includes a bottom cover 11, a test strip 13, a mylar window 15, and a top cover 17 (see col. 8, lines 2-5). In Burd, the top cover 17 is provided with a sample introduction aperture 35 and an indicator aperture 37, wherein the sample introduction aperture 35 is located above a sample zone 23 on the test strip 13, and the indicator aperture is located above the mylar window 15 (see col. 9, lines 38-40).

The device of Burd operates by having a sample of blood introduced through the sample introduction aperture 35 such that the sample zone 23 receives the blood (see col. 9, lines 57-67). After the sample is introduced through the sample introduction aperture 35, the sample flows along the test strip 13 such that the presence, absence or an amount of an analyte can be determined (see col. 9, lines 33-35 and col. 10, lines 4-14).

In the Office Action, the Examiner takes the position that an empty space is formed between the sample introduction aperture 35 and the surface of the sample zone 23 of Burd, wherein this empty space corresponds to a “cavity part” as recited in claim 1 (see Office Action at pages 17-18).

Applicants note, however, that while a space may arguably be formed between the sample introduction aperture 35 and the surface of the sample zone 23, that a blood sample does not flow into such a space by a capillary phenomenon. In direct contrast, Applicants note that in Burd, an instrument such as a dropper or a pipette is needed which can directly supply the blood sample through the aperture 35 to the sample zone 23.

Thus, as a device is needed in Burd which can directly supply the blood sample through the aperture 35 to the sample zone 23, it is clear that a capillary phenomenon is not in any way whatsoever involved in the introduction of the blood sample to a space that is located between the sample zone 23 and the aperture 35 of Burd.

In view of the foregoing, Applicants respectfully submit that Burd fails to disclose or suggest the feature of a space forming part which forms a cavity part, wherein the cavity part is a space into which an inspection target solution flows by a capillary phenomenon, as recited in claim 1. Accordingly, Applicants submit that claim 1 is patentable over Burd, an indication of which is kindly requested.

According to the present invention, by constructing a cavity part such that an inspection target solution can flow into the cavity part by a capillary phenomenon, it is not necessary to use an instrument such as a dropper or pipette in order to introduce the sample, thereby providing a measurement device that is easy to use and is capable of high precision measurement.

In addition, Applicants note that claim 1 has also been amended to recite that an amount of inspection target solution which flows into said cavity part is regulated by a volume of said cavity part. Applicants respectfully submit that Burd does not disclose or suggest such a feature.

As noted above, the Examiner has taken the position that a space between the sample zone 23 and the aperture 35 of Burd corresponds to a “cavity part” as recited in claim 1.

Applicants respectfully submit, however, that because Burd requires a device such as a dropper or pipette that directly supplies a blood sample to the sample zone 23, Applicants submit that the amount of blood which is supplied to the sample zone 23 is not regulated by the volume of a space between the sample zone 23 and the aperture 35.

In view of the foregoing, Applicants respectfully submit that Burd does not disclose or suggest that an amount of inspection target solution which flows into the cavity part is regulated by a volume of the cavity part, as recited in claim 1. Accordingly, Applicants submit that claim 1 is patentable over Burd, an indication of which is kindly requested.

Claims 3, 10-12, 17, 18, 20 and 21 depend from claim 1, and are therefore considered patentable at least by virtue of their dependency.

In addition, regarding claim 17, Applicants note that this claim recites that the space forming part includes an air vent for assisting the target solution in flowing into the cavity part. In the Office Action, the Examiner asserts that, in Burd, the top cover 17 with the sample introduction aperture 35 corresponds to the “space forming part” as recited in the claimed invention (see Office Action at page 3), and that the slits 39 in the top cover 17 correspond to the “air vent” as recited in the claimed invention.

Applicants note, however, that claim 1 (from which claim 17 depends) has been amended to recite that the space forming part is located only at a part upstream of the reagent immobilization part in a permeating direction of the inspection target solution. In this regard,

Applicants note that the Examiner has taken the position in the Office Action that the capture zone 29 of Burd corresponds to the “reagent immobilization part” as recited in the claimed invention.

Accordingly, as shown in Fig. 1 of Burd, as the slits 39 are clearly located downstream of the capture zone 29 (Applicants note that the capture zone 29 is mistakenly labeled as element 69 in Fig. 1 of Burd), and claim 1 has been amended to recite that the space forming part is located only at a part upstream of the reagent immobilization part in a permeating direction of the inspection target solution, it is clear that the slits 39 of Burd cannot be considered as part of the space forming part.

Therefore, based on the above-noted amendment to claim 1 which recites that the space forming part is located only at a part upstream of the reagent immobilization part in a permeating direction of the inspection target solution, Applicants respectfully submit that the part of the cover 17 that is located downstream of the capture zone 29 cannot correspond to the space forming part as recited in the claimed invention.

Accordingly, as the slits 39 are located in the part of the cover 17 that is located downstream of the capture zone 29, Applicants respectfully submit that Burd does not disclose or suggest that a space forming part includes an air vent for assisting the target solution in flowing into the cavity part, as recited in claim 17. Thus, Applicants submit that claim 17 is patentable over Burd, an indication of which is kindly requested.

Regarding claim 2, Applicants note that this claim has been amended in a similar manner as discussed above regarding claim 1. Accordingly, for at least the same reasons as

discussed above with respect to claim 1, Applicants submit that Burd fails to disclose, suggest or otherwise render obvious all of the features recited in amended claim 2. Accordingly, Applicants submit that claim 2 is patentable over Burd, an indication of which is kindly requested.

Claims 29, 30, 31, 36, 37, 39 and 40 depend from claim 2. Accordingly, Applicants submit that these claims are patentable at least by virtue of their dependency.

In addition, Applicants note that claim 36 recites that the space forming part includes an air vent for assisting the inspection target solution in flowing into the cavity part. For at least the same reasons as discussed above with respect to claim 17, Applicants submit that Burd does not disclose or suggest such a feature. Accordingly, Applicants submit that claim 36 is patentable over Burd, an indication of which is kindly requested.

III. Claim Rejections under 35 U.S.C. § 103(a)

A. The Examiner has rejected claims 6 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Burd et al. in view of Bernstein et al. (U.S. 5,824,268).

Claim 6 depends from claim 1, and claim 25 depends from claim 2. Applicants respectfully submit that Bernstein fails to cure the deficiencies of Burd, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claim 6 and 25 are patentable at least by virtue of their dependency.

B. The Examiner has rejected claims 7 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Burd et al. in view of Killeen et al. (U.S. 5,166,051).

Claim 7 depends from claim 1, and claim 26 depends from claim 2. Applicants respectfully submit that Killeen fails to cure the deficiencies of Burd, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claim 7 and 26 are patentable at least by virtue of their dependency.

C. The Examiner has rejected claims 8 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Burd et al. in view of Barr (U.S. 4,252,538). Claim 8 depends from claim 1, and claim 27 depends from claim 2. Applicants respectfully submit that Barr fails to cure the deficiencies of Burd, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claim 8 and 27 are patentable at least by virtue of their dependency.

D. The Examiner has rejected claims 9, 16, 28 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Burd et al. in view of Allen et al. (U.S. 5,426,000).

As noted above, claims 16 and 35 have been canceled by this amendment. Regarding claims 9 and 28, Applicants note claim 9 depends from claim 1 and that claim 28 depends from claim 2. Applicants respectfully submit that Allen fails to cure the deficiencies of Burd, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claims 9 and 28 are patentable at least by virtue of their dependency.

E. The Examiner has rejected claims 14 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Burd et al. in view of Woudenberg et al. (U.S. 6,124,138).

As noted above, claims 14 and 33 have been canceled by this amendment, thereby rendering this rejection moot.

F. The Examiner has rejected claims 19 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Burd et al. in view of Kloefer (U.S. 4,883,764).

Claim 19 depends from claim 1, and claim 38 depends from claim 2. Applicants respectfully submit that Kloefer fails to cure the deficiencies of Burd, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claim 19 and 38 are patentable at least by virtue of their dependency.

IV. Double Patenting Rejection

Claims 1-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/069,845 in view of Burd et al. Applicants note that the Examiner also identifies Application Nos. 10/133,698, 10/398,711, 10/048,727, 10/116,407 and 10/242672 and asserts that these applications would also require similar provisional obviousness-type double patenting rejections as set forth for Application No. 10/069,845.

As the above-noted rejection of claims 1-40 under obviousness-type double patenting is provisional, Applicants hereby request that the rejection be held in abeyance. If the provisional double patenting rejection is the only remaining rejection in the application, Applicants will file a terminal disclaimer, if necessary, to overcome such a rejection. See MPEP 804(I)(B).

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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